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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Javit A. Drake et al. Art Unit : 1745
Serial No. : 10/664,822 Examiner : Robert W. Hodge
Filed : September 16, 2003 Conf. No. : 3431
Title : ENHANCED FUEL DELIVERY FOR DIRECT METHANOL FUEL CELLS

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed August 24, 2006, applicant elects the invention of Group II drawn to the embodiment of a second fuel cartridge. The election is made with traverse at least for the reasons discussed below:

The examiner required restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a first fuel cartridge, classified in class 429, subclass 34.
- II. Claims 11-23, drawn to a second fuel cartridge, classified in class 429, subclass 34.
- III. Claims 24-33, drawn to a membrane in a fuel cartridge, classified in class 429, subclass 35.
- IV. Claims 34-38, drawn to a fuel cell arrangement, classified in class 429, subclass 30.
- V. Claim 39, drawn to a method of operating an electronic device, classified in class 429, subclass 12.

The examiner contends that inventions are distinct, each from the other because:

“Inventions I & II and IV are related as combination and subcombination.” Applicant disagrees.

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Date of Deposit

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Marie Collins

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Marie Collins

Applicant does not believe that there is any combination/sub-combination relationship between inventions I and II.

The examiner also contends that Inventions III and I & II are related as mutually exclusive species in an intermediate-final product relationship. The examiner contends that:

Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as a membrane in either of the two distinct fuel cartridges found in claim groups I & II and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

Applicant traverses this restriction requirement, since it is at odds with the initial restriction requirement made for Inventions I, II and IV. Additionally, inventions II and III are related as combination, sub-combination, and in order for the examiner to properly restrict these inventions, the examiner must show that they are independent and distinct.

In order for a restriction requirement to be proper, the examiner must show that the inventions are independent (no disclosed relationship therebetween) and distinct (meaning two or more subjects as disclosed are related). Both conditions must be present, in order to properly find a requirement for restriction.¹

The examiner in the office action misconstrued the law by stating: "an invention that is independent or distinct" and has not adequately addressed either requirement. For two inventions to be independent, the inventions cannot be dependent. The examiner has not shown that inventions I and III are independent.

M.P.E.P. §802.01 sets forth the meaning of independent:

¹ 35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application.

In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

M.P.E.P. §802.01

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

Clearly, a composite membrane and a composite membrane residing in the fuel cartridge reciting functionally equivalent elements are not independent inventions.

In order for the requirement to be proper, however, the examiner must also show that the inventions are distinct. The examiner has not properly addressed the distinctiveness requirement that is necessary to have a proper restriction. M.P.E.P. §802.01 also sets forth the meaning of distinct:

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

The examiner has failed to address how an Invention II would be capable of separate sale as Invention III and how Invention II, which recites the same functional limitations of Invention III would be novel and unobvious over each other.

The examiner's argument does not address the test of whether the claims are "distinct," that is, being capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner also indicated that the application contained claims directed to the following patentably distinct species:

Species 1 figure 2a

Species 2 figure 2b

Species 3 figure 2c

Species 4 figure 2d

Species 5 figure 2c

Applicant, pursuant to 35 U.S.C. 121, elects the disclosed species of Figure 2B for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. This election is made with traverse because of the errors in the underlying restriction requirement.

Claims 11-34 and 39 are readable on Figure 2B and at least claim 24 is generic.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

9/25/06

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